



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,606	08/24/2001	Masuyo Horiguchi	PNDF-01114	8991
30743	7590	06/16/2005	EXAMINER	
WHITHAM, CURTIS & CHRISTOFFERSON, P.C. 11491 SUNSET HILLS ROAD SUITE 340 RESTON, VA 20190			SING, SIMON P	
			ART UNIT	PAPER NUMBER
			2645	

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/935,606

Applicant(s)

HORIGUCHI, MASUYO

Examiner

Simon Sing

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-9 and 11-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-9 and 11-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>03152005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Nguyen US 5,797,089.

Nguyen discloses a personal communication terminal 10 has independently energized a mobile telephone and a personal digital assistant (PDA) in figures 1 and 2 (column 3, lines 36-67; column 4, lines 1-22). Nguyen teaches means (switches 25 and 26) for interchanging a communication mode and a non-communication mode by turning the one switch on and the other off. When the phone power switch 26 is off and PDA power switch 25 is on, an indicator 27 lights up for indicating the terminal 10 is in the PDA (non-communication) mode. Switches 25 (ON) and 26 (OFF) are controlling means for stops the personal communication terminal's telephone function and lighting up the PDA indicator. The PDA indication 27 is situated at a position (figure 2) easily seen by persons other than a user when the terminal 10 is opened.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atsushi Japanese Patent publication Number 11-308163 in view of Korycan US 5,950,139.

2.1 Regarding claim 1, Atsushi discloses a portable telephone in figures 1 and 2, Atsushi teaches a stop key 6d, which when pressed, a central processing unit 4 disconnects DC power to radio units 2 and 3, disabling its telephone function, and a non-communicative mode indicator (figure 5) appears on display unit 7 (figure 4) (section 0018-036). Atsushi teaches that central processing unit 4 indicates the non-communicative mode in the display unit 7 by lighting up an indicator, but fails to teach indicating the non-communicative mode by lighting a lamp and easily seen by others.

However, Korycan discloses a radiotelephone in figures 1-5. Korycan teaches that an indicators, such as a signal strength indicator, normally appears in a display unit can be replaced by LED lamps for better viewing (column 1, lines 11-18, 57-67; column 2, lines 16-23). The LED lamps are easily seen by persons other than the user.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Atsushi's reference with the teaching of

Art Unit: 2645

Korycan, so that the non-communicative mode indicator in the display unit 7 would have been replaced by a LED, located on the housing of the portable telephone, because a LED lamp would have provided a better viewing, and replacing the non-communicative indicator in a display with a LED lamp would have been a design choice, since it did not alter the functionality of Atsushi's.

2.2 Regarding claim 2, as discussed in claim 1, Atsushi teaches a stop key 6d for disabling radio units 2 and 3.

2.3 Regarding claim 3, as discussed in claim 1, the lamp lights up continuously in the non-communicative mode.

2.4 Regarding claim 6, a portable telephone inherently has key-tone on/off feature selectable through a menu.

3. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Atsushi Japanese Patent publication Number 11-308163 in view of Korycan US 5,950,139 and further in view of Delarminat et al. US 6,262,686 and further in view of Ishihara US 6,167,288.

The Atsushi reference, modified by Korycan, teaches lighting up a LED lamp when the portable telephone in the non-communication mode, but fails to teach that the LED lamp is situated on an antenna and notifies a reception of a radio wave.

However, Delarminat discloses an antenna for a cellular phone in figure 1 (column 1, lines 7-10, 62-65). Delarminat teaches that the antenna comprises a LED 9 (column 1, lines 62-65; column 2, lines 37-40).

In addition, Ishihara discloses a portable telephone set with a LED 2, indicating whether the portable telephone set is for communications or for non-communications by using different colors, or continuous lighting Vs. flashing (figures 1-3; column 1, lines 16-26; column 6, lines 21-26).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the Atsushi's reference, which was modified by Korycan, with the teachings of Delarminat and Ishihara, so that the non-communicative mode indicator would have been situated on an antenna and would have been able to notify a user of reception of radio waves by changing its color or by flashing, because situating the LED lamp on an antenna would have made it more noticeable to a user and others, and lighting up the LED in another color or by flashing would have notified a user of different communicative modes.

Art Unit: 2645

4. Claims 7-9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atsushi Japanese Patent publication Number 11-308163 in view of Korycan US 5,950,139 and further in view of Nonogaki US 6,625,478.

4.1 Regarding claim 7, Atsushi discloses a portable telephone in figures 1 and 2, Atsushi teaches a stop key 6d, which when pressed, a central processing unit 4 disconnects DC power to radio units 2 and 3, disabling its telephone function, and a non-communicative mode indicator (figure 5) appears on display unit 7 (figure 4) (section 0018-036). Atsushi teaches that central processing unit 4 indicates the non-communicative mode in by displaying an non-communication mode indicator the display unit 7, but fails to teach indicating the non-communicative mode by lighting a lamp which is easily seen by others, and urging a user to choose a communicative mode or a non-communicative mode when power up.

However, Korycan discloses a radiotelephone in figures 1-5. Korycan teaches that an indicators, such as a signal strength indicator, normally appears in a display unit can be replaced by LED lamps for better viewing (column 1, lines 11-18, 57-67; column 2, lines 16-23). The LED lamps are easily seen by persons other than a user.

In addition, Nonogaki discloses a wireless telephone in figure 1. The wireless telephone has three operation modes, AV mode (non-communicative mode), telephone/AV mode and telephone mode (communicative mode) (Abstract; column 6, lines 1-13). Nonogaki teaches that in a stand-by state, power to all modules (VA module 200, telephone module 300 and common module (including display) 400) are off

Art Unit: 2645

except power management controller 101 (column 8, lines 39-49), and when power switch K1 is pressed, the device is turned-on and displays an operation mode, urging a user to confirm by pressing power switch K2, the user may press K2 to select the operation mode displayed, or press K1 again to change the operation mode (column 9, lines 1-22, 41-59). Nonogaki also teaches displaying a warning message when a telephone mode (or telephone/AV mode) is selected (column 9, lines 41-59).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Atsushi's reference with the teachings of Korycan and Nonogaki, so that the non-communicative mode indicator in the display unit 7 would have been replaced by a lamp, located on the housing of the portable telephone, and the display unit 7 would have urged a user to decide an operation mode, such as a communicative mode or a non-communicative mode, because replacing the non-communicative mode indicator in the display with a LED lamp on the housing would have provided a better viewing, and replacing the non-communicative indicator in a display with a LED lamp would have been a design choice sine it did not alter the functionality of Atsushi's, and urging a user to choose an operating mode would have provide a warning message to a user to turn off the radio unit in case said portable telephone was power-up in a restricted area.

4.2 Regarding claim 8, the Atsushi's teaches using a switch 6d for disabling the radio units 2 and 3 and replacing switch 6d with a touch screen switch would have been a design choice since it just replaced one type of switch (mechanical) with another type

Art Unit: 2645

(electrical) and would not have changed the functionality of the modified Atsuahi's portable telephone.

4.3 Regarding claim 9, as discussed in claim 7, the LED lamp lights up continuously in the non-communicative mode.

4.4 Regarding claim 12, a portable telephone inherently has key-tone on/off feature selectable through a menu.

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Atsushi Japanese Patent publication Number 11-308163 in view of Korycan US 5,950,139 and further in view of Nonogaki US 6,625,478 and further in view of Delarminat et al. US 6,262,686 and further in view of Ishihara US 6,167,288.

The Atsushi reference, modified by Korycan and Nonogaki, teaches lighting up a LED lamp when the portable telephone in the non-communication mode, but fails to teach that the LED lamp is situated on an antenna and notifies a reception of a radio wave.

However, Delarminat discloses an antenna for a cellular phone in figure 1 (column 1, lines 7-10, 62-65). Delarminat teaches that the antenna comprises a LED 9 (column 1, lines 62-65; column 2, lines 37-40).

Art Unit: 2645

In addition, Ishihara discloses a portable telephone set with a LED 2, indicating whether the portable telephone set is for communications or for non-communications by using different colors, or continuous lighting Vs. flashing (figures 1-3; column 1, lines 16-26; column 6, lines 21-26).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the Atsushi's reference, which was modified by Korycan and Nonogaki, with the teachings of Delarminat and Ishihara, so that the non-communicative mode indicator would have been situated on an antenna and would have been able to notify a user of reception of radio waves by changing its color or by flashing, because situating the LED lamp on an antenna would have made it more noticeable, and lighting up the LED in another color or by flashing would have notified a user that the portable telephone was in which communicative mode.

6. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Atsushi Japanese Patent publication Number 11-308163 in view of Korycan US 5,950,139 and further in view of Delarminat et al. US 6,262,686.

The Atsushi reference, modified by Korycan, teaches lighting up a LED lamp when the portable telephone in the non-communication mode, but fails to teach that the LED lamp is situated on an antenna.

However, Delarminat discloses an antenna for a cellular phone in figure 1 (column 1, lines 7-10, 62-65). Delarminat teaches that the antenna comprises a LED 9 (column 1, lines 62-65; column 2, lines 37-40).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the Atsushi's reference, which was modified by Korycan, with the teaching of Delarminat, so that the non-communicative mode indicator would have been situated on an antenna, because situating the LED lamp on an antenna would have made it more noticeable to a user and others.

7. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Atsushi Japanese Patent publication Number 11-308163 in view of Korycan US 5,950,139 and further in view of Nonogaki US 6,625,478 and further in view of Delarminat et al. US 6,262,686.

The Atsushi reference, modified by Korycan and Nonogaki, teaches lighting up a LED lamp when the portable telephone in the non-communication mode, but fails to teach that the LED lamp is situated on an antenna.

However, Delarminat discloses an antenna for a cellular phone in figure 1 (column 1, lines 7-10, 62-65). Delarminat teaches that the antenna comprises a LED 9 (column 1, lines 62-65; column 2, lines 37-40).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the Atsushi's reference, which was

Art Unit: 2645

modified by Korycan and Nonogaki, with the teaching of Delarminat, so that the non-communicative mode indicator would have been situated on an antenna, because situating the LED lamp on an antenna would have made it more noticeable to a user and others.

Response to Arguments

8. Applicant's arguments filed on 12/22/2004 have been fully considered but they are not persuasive.

a). Claim 1 anticipated by Nguyen: The applicant argues that the PDA lamp (non communicative mode indicator) is not easily seen by others since it is seen only when the device 10 is open. Since easily seen is a relative term, or indefinite, a lamp is easily seen by people standing or sitting closed by, may not be easily seen by people from far away. In Nguyen, when device 10 is operated in a PDA mode, the device is opened and PDA lamp is on and is easily seen by others. Therefore, Nguyen reads on the claimed inventions. When not in PDA mode, or when the device 10 is closed, the lamp is off, and when a lamp is off, no matter where it is situated, is ***not*** easily seen by others. In other words, a lamp is easily seen by others closed by only when it is on.

b). Claim 1 is rejected by Atsushi in view of Korycan (and Nonogaki for claim 7). The applicant argues that none of the references teaches an external lamp for notifying other people that the portable telephone is not being used for communication.

However, the applicant only claims a lamp situated at a position easily seen by others (examiner note: easily seen is a relative term, that is, a lamp, when it is on, is easily seen by person with good eye sight and not easily seen by a people with bad eye sight, or is easily seen by people near by but not by people far away, and a lamp is definitely **not** easily seen when it is off), not an external lamp, nor notifying others of a none-communicative mode, but a lamp for others to see. Claim 1 never shows how other people are notified of a none-communicative mode when they only see a lamp, since there are other lamps on a portable telephone, such as power lamp and signal lamp, there in way that other people are notified of a none communicative mode when a lamp on a lamp on portable telephone lit up. Therefore, the argument presented is invalid, and Atsushi in view of korycan (and Nonogaki) teach the claimed invention.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 2645

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Simon Sing whose telephone number is (571) 272-7545. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached at (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2600.



S. Sing

06/10/2005



FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600